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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/890,889	08/07/2001	Jorg Hofmann	MO-6495/LEA3	9240

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BAYER MATERIAL SCIENCE LLC
100 BAYER ROAD
PITTSBURGH, PA 15205

EXAMINER

FEELY, MICHAEL J

ART UNIT PAPER NUMBER

1712

DATE MAILED: 06/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/890,889

Applicant(s)

HOFMANN ET AL.

Examiner

Michael J. Feely

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-23 and 25-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 19 and 26-31 is/are allowed.
- 6) ☒ Claim(s) 12-18, 20-23 and 25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Pending Claims

Claims 12-23 and 25-31 are pending.

Previous Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. The rejection of claim 24 under 35 U.S.C. 112, second paragraph, has been rendered moot by the cancellation of claim 24.

Previous Claim Rejections - 35 USC § 102/103

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
4. The rejection of claim 24 under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Hofmann et al. (WO 99/46042) has been rendered moot by the cancellation of claim 24.
5. The rejection of claim 24 under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Hofmann et al. (EP 0892002 A1) and Herold (US Pat. No. 3,829,505) has been rendered moot by the cancellation of claim 24.
6. The rejection of claim 24 under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Hofmann et al (US Pat. No. 5,998,327) has been rendered moot by the cancellation of claim 24.

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Terminal Disclaimer

7. The terminal disclaimers filed on March 28, 2005 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of:

- Any patent granted on Application Serial No. 10/717,093;
- US Pat. No. 6,833,431 (Application Serial No. 10/133,287);
- Any patent granted on Application Serial No. 10/138,209;
- Any patent granted on Application Serial No. 10/129,579;
- US Pat. No. 6,696,383 (Application Serial No. 10/251,155); and
- US Pat. No. 6,797,665 (Application Serial No. 10/143,234),

have been reviewed and are accepted. The terminal disclaimers have been recorded.

Additional Double Patenting

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 12, 14, 15, 17, 18, and 25 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 5 and 6 of copending Application No. 10/493,608. Although the conflicting claims are not identical, they

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are not patentably distinct from each other because the embodiments of the instant invention substantially overlap the claimed catalyst in the copending claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

10. Claims 12-18 and 25 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7 of U.S. Patent No. 6,867,162.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the embodiments of the instant invention substantially overlap the claimed catalyst in the patent.

11. Claims 12, 14, 15, 17, 18, and 25 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 4 of U.S. Patent No. 6,764,978. Although the conflicting claims are not identical, they are not patentably distinct from each other because the embodiments of the instant invention substantially overlap the claimed catalyst in the patent.

12. Claims 12-18, 20-22, and 25 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8 of U.S. Patent No. 6,852,663. Although the conflicting claims are not identical, they are not patentably distinct from each other because the embodiments of the instant invention substantially overlap the claimed catalyst in the patent. It should be noted that 6,852,663 defines “ionic surfactant compound” to include bile acid salts and amides – *see column 9, lines 23-61; MPEP804 1.*

13. Claims 12-18, 21-23, and 25 rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7 and 14-19 of U.S.

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Patent No. 6,586,566. Although the conflicting claims are not identical, they are not patentably distinct from each other because the embodiments of the instant invention substantially overlap the claimed catalyst in the patent. It should be noted that 6,586,566 defines “monomeric ionic-surface or interface-active compound” to include bile acid salts and amides – *see column 4, lines 1-20; MPEP804 1.*

Allowable Subject Matter

14. Claims 19 and 26-31 are allowed.
15. Claims 12-18, 20-23, and 25 would be allowable if rewritten or amended to overcome the obvious-type double patenting rejection(s) set forth in this Office action; or with timely filed terminal disclaimer(s).
16. The following is a statement of reasons for the indication of allowable subject matter:
Hofmann et al. (WO 99/46042 & US equivalent 6,291,388) and Hofmann et al. (WO 99/19063 & US equivalent 6,323,375) are the closest prior art. They disclose similar DMC catalyst to that of instant claims 12 and 19; however, they provide no motivation to include at least one bile acid or its salt, ester or amide in combination with at least one double-metal cyanide compound and at least one non-bile organic complex ligand.

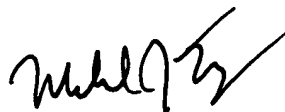
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Communication

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael J. Feely whose telephone number is 571-272-1086. The examiner can normally be reached on M-F 8:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on 571-272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Michael J. Feely
Primary Examiner
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June 10, 2005